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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,565	01/23/2004	Philippe Gambier	68.0418	4887

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ROSHARON, TX 77583

EXAMINER

COY, NICOLE A

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/763,565	Applicant(s) GAMBIER, PHILIPPE	
	Examiner Nicole Coy	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-27 and 31-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-27 and 32-36 is/are allowed.
- 6) ☒ Claim(s) 43-47, 49 and 50 is/are rejected.
- 7) ☒ Claim(s) 31, 37-42, 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/27/06, 6/25/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: It is unclear what the term "bow" means. It does not appear to mean bow spring, as the disclosure separately references springs as an embodiment. It also does not appear to indicate a shape, as figures 5A and 5B depict the "bow" and they are not in a conventional bow shape. Thus, appropriate correction is required.
2. Claims 31 and 37-42 are objected to because of the following informalities: It is unclear what the term "bow" means. It does not appear to mean bow spring, as the disclosure separately references springs as an embodiment. It also does not appear to indicate a shape, as figures 5A and 5B depict the "bow" and they are not in a conventional bow shape. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 44 and 45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how a metallic substrate or composite material is held in a first position to store potential energy and then released, in order to release some of the potential energy. It is also unclear what mechanism holds the metallic substrate or composite material in a first position. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 43, 44, 49, and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Simpson et al.

With respect to claim 43, Simpson et al. discloses a seal element for use in a packer comprising: an energizing element (62) adapted to store potential energy prior to the packer being run to a predetermined position in a well (wherein 62 inherently stores potential energy before it expands; see figures 6 and 7); a sealing layer (64) covering at least a portion of the energizing element; and a mechanism (71) adapted to hold the energizing element in a first position prior to the packer being run into the well to store the potential energy and release the energizing element downhole in the well to release

at least some of the potential energy at the predetermined position to radially expand the energizing element and establish contact between the sealing layer and a wall enclosing the packer (see figures 6 and 7).

With respect to claim 44, Simpson et al. discloses that the energizing element (62) comprises a metallic substrate.

With respect to claim 49, Simpson et al. discloses a method usable with a well comprising: storing potential energy in a seal element (64, 62) of a packer before deploying the packer downhole in the well; after the storing, running the packer into the well; positioning the packer at a position at which a seal is to be formed in an annulus of the well (see figure 6 and 7); setting the packer by releasing at least some of the potential energy to form a seal between the packer and a wall surrounding the packer; and maintaining the seal using at least some of the potential energy remaining in the potential energy stored in the seal element (see figures 6 and 7).

With respect to claim 50, Simpson et al. discloses that the storing is performed by at least deforming an elastic substrate of the seal element (wherein 64 is elastomeric and it inherently stores potential energy when deformed).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al.

With respect to claim 45, Simpson et al. does not disclose that the energizing element comprises a composite. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used a composite material for the energizing element, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claims 46 and 47, Simpson et al. does not disclose pins or springs. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used a pin or spring as an energizing element, since the examiner takes Official Notice of the equivalence of pins/springs and expanding tubing for their use in the packer art and the selection of any of these known equivalents to store potential energy to form a seal would be within the level of ordinary skill in the art.

Allowable Subject Matter

9. Claims 25-27, 32-36 are allowed.

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10. Claim 48 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed 4/27/06 have been fully considered but they are not persuasive with respect to claims 43-50. Applicant argues that no reference teaches storing potential energy. However, based on the fact that the tubing element is expandable, Simpson et al. inherently discloses storing potential energy. In view of the new objections/rejections presented above, this rejection is made non-final.

Conclusion

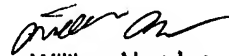
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole Coy whose telephone number is 571-272-5405. The examiner can normally be reached on M-F 7:30-5:00, 1st F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

nac


William Neuder
Primary Examiner